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Practitioner's Docket No. U013560-1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re prior application of: Noel J. de Souza, et al.
Application No.: 09/919,347
Filed: July 31, 2001
For: INHIBITORS OF CELLULAR EFFLUX PUMPS OF MICROBES

Group No. 1625
Examiner: D. Margaret Seaman

NOTE: "In addition to identifying the application number of the prior application, applicant should furnish in the request for an application under this paragraph the following information relating to the prior application to the best of his or her ability: (i) Title of invention; (ii) Name of applicant(s); and (iii) Correspondence address." 37 C.F.R. Section 1.53(d)(8).

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PATENT TRADEMARK OFFICE

Box CPA
Assistant Commissioner for Patents
Washington, D.C. 20231



CONTINUED PROSECUTION APPLICATION (CPA)
(37 C.F.R. SECTION 1.53(d))

WARNING:

CPA practice does **not** apply (other than designs) where the prior application has a filing or CPA date on or after May 29, 2000.

NOTE:

A continued prosecution application can only be used to file a divisional or continuation of a prior nonprovisional application and can **NOT** be used to file a continuation-in-part application. 37 C.F.R. Section 1.53(d)(1).

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.10

(When using Express Mail, the Express Mail label number is **mandatory**.
Express Mail certification is optional.)

I hereby certify that, on the date shown below, this correspondence is being:

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37 C.F.R. Section 1.10*

☒

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Mailing Label No. EV011023824US (mandatory)

Date: August 12, 2002

Signature

Janet I. Cord

(type or print name of person certifying)

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(Continued Prosecution Application (CPA))--page 1 of 12) 4-2

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WARNING: While facsimile transmission can be used to obtain a date of transmission for this correspondence the date on the certificate of transmission (Section 1.8(a)) of an application under Section 1.53(d) (CPA) is not controlling (or even relevant), in that a CPA filed by facsimile transmission will not be accorded filing date as of the date on the certificate of transmission (Section 1.8(a)) unless Office records indicate, or applicant otherwise establishes pursuant to Section 1.6(f), receipt in the Office of the complete application under Section 1.53(d) on the date on the certificate of transmission, and that date is not a Saturday, Sunday, or Federal holiday.. 37 C.F.R. Section 1.8(b)(3) and 62 Fed. Reg. 53133, October 10, 1997. Requests for a continued prosecution application filed by facsimile transmission should be clearly marked "Box CPA". 37 C.F.R. Section 1.53(d)(9).

Before using the CPA procedure note that a CPA application (Section 1.53(d)) cannot be amended to delete the specific reference to a prior application (e.g., for patent term purposes), as well as the specific reference to any application to which the prior application contains a specific reference under 35 U.S.C. Section 120, 121 and 365(c) and the expiration date under 35 U.S.C. Section 154(b)(2) of any patent issuing from the Section 1.53(d) application will be based upon the filing date of the prior application (or the earliest application to which the prior application contains a reference under 35 U.S.C. Section 120, 121, and 365(c)). 62 Fed. Reg. 53,131, 53,145, October 10, 1997.

WARNING: A continued prosecution application "Is a request to expressly abandon the prior application" as of its filing date. 37 C.F.R. Section 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 C.F.R. Section 1.53(b).

WARNING: While the filing of a continued prosecution application is the specific reference required by 35 U.S.C. Section 120 to every application assigned the application number identified in such request, no amendment in the application may delete the specific reference to any prior application (e.g., for patent term purposes). 37 C.F.R. Section 1.53(d)(7).

WARNING: A request for an application under Section 1.53(d) (CPA) cannot be submitted within papers filed for another purpose (e.g., the filing of a "conditional" request for a continued prosecution application within an amendment after final for the prior application). A "conditional" request for a CPA submitted (as a separate paper) with an amendment after final will be treated as an unconditional request for a CPA. This will result (Section 1.53(d)(2)(v)) in the abandonment of such prior application, and (if so instructed in the request for CPA) the amendment after final in the prior application will be treated as a preliminary amendment in the CPA. 62 Fed. Reg. 53,131, 53,140, October 10, 1997.

NOTE: "The filing date of a continued prosecution application is the date on which a request on a *separate* paper for an application...is filled." 37 C.F.R. Section 1.53(d)(2)(emphasis added).

1. This is a request for a filing of a
[X] continuation
[] divisional

continued prosecution application under 37 C.F.R. Section 1.53(d) of the above identified prior nonprovisional application.

WARNING: "A request for a CPA expressly abandons the prior application as of the filing date of the request for the CPA. See 37 C.F.R. Section 1.53(d)(2)(v). Therefore, where the prior application is not to be abandoned, any continuation or divisional application must be filed under 37 C.F.R. Section 1.53(b)." M.P.E.P. Section 201.06(d), 7th ed.

It is further requested that this continued prosecution application utilize the file jacket and contents of the prior application, including the specification, drawings and oath or declaration from the prior application, to constitute this new application, and that the application number of the above identified prior application be assigned for identification purposes. 37 C.F.R. Section 1.53(d)(2)(iv).

NOTE: Since a CPA cannot contain new matter, the oath or declaration filed in the prior nonprovisional application would supply all the information required under 35 U.S.C. Section 111(a) and the rules to have a complete application and to obtain a filing date. Accordingly, the previously filed oath or declaration will be considered to be the oath or declaration of the CPA. M.P.E.P. Section 201.06(d), 7th ed.

It is also requested that the above-identified prior application be expressly abandoned as of the filing date accorded this continued prosecution application. 37 C.F.R. Section 1.53(d)(2)(v).

2. With respect to the above-identified prior nonprovisional application this continued prosecution application is being filed:

- A. ☒ before the earliest of the:
☒ termination of the proceedings on the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(C).
☒ payment of the issue fee on the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(A).
☒ abandonment of the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(B).

OR

- B. ☐ after the payment of the issue fee but a petition under Section 1.313(b)(5) has been granted in the prior application. 37 C.F.R. Section 1.53(d)(1)(ii)(A).

NOTE: "If an extension of time is necessary to establish continuity between the prior application and the CPA, the petition for extension of time should be filed as a separate paper directed to the prior nonprovisional application. However, a CPA is not improper simply because the request for a CPA is combined in a single paper with a petition for extension of time. . . .

"While the filing of a CPA is not strictly a reply to an Office action mailed in a prior application, a request for a CPA is a paper directed to and placed in the file of the prior application, and seeks to take action in (i.e., expressly abandon) the prior application. Thus, it will be considered a "reply" for purposes of 37 C.F.R. Section 1.136(a)(3). As a result, an authorization in the prior application to charge all required fees, fees under 37 C.F.R. Section 1.17, or all required extension of time fees to a deposit account will be treated as a constructive petition for an extension of time in the prior application for the purposes of establishing continuity with the CPA. The correct extension fee to be charged in the prior application would be the extension fee necessary to establish continuity between the prior application and the CPA on the filing date of the CPA.

"If an extension of time directed to the prior application is filed as a separate paper, it must be accompanied by its own certificate of mailing under 37 C.F.R. Section 1.8 (if mailed by first class mail) or under 37 C.F.R. Section 1.10 (if mailed by Express Mail), of the benefits of those rules are desired."

M.P.E.P. Section 201.06(d), 7th ed.

C. The term for response or taking action in the prior application expires on August 12, 2002.

☐ An extension of time in the prior application is:

☒ filed concurrently by the next entry below in the prior application
☐ has been filed on _____.

☒ Applicant petitions for an extension of time under 37 C.F.R. 1.136(a)
(fees: 37 C.F.R. 1.17(a)(1)-(4)) for the total number of months checked
below:

	Extension (months)	Fee for other than small entity	Fee for small entity
<input type="checkbox"/>	one month	\$ 110.00	\$ 55.00
<input type="checkbox"/>	two months	\$ 400.00	\$ 200.00
<input checked="" type="checkbox"/>	three months	\$ 920.00	\$ 460.00
<input type="checkbox"/>	four months	\$ 1,440.00	\$ 720.00

Fee: \$ 920.00

If an additional extension of time is required, please consider this a petition therefor.

(check and complete the next item, if applicable)

☐ An extension for _____ months has already been secured. The fee paid therefor of
\$ _____ is deducted from the total fee due for the total months of extension
now requested.

Extension fee due with this request \$ _____

OR

☐ Applicant believes that no extension of term is required. However, this conditional
petition is being made to provide for the possibility that applicant has inadvertently
overlooked the need for a petition for extension of time.

3. It is noted that:

- * This application discloses and claims only subject matter disclosed in the prior application. 37 C.F.R. Section 1.53(d)(2)(ii).
- * Filing of this continued prosecution application is to be construed to include a waiver of confidentiality by the applicant under 35 U.S.C. Section 122 to the extent that any member of the public, who is entitled under the provisions of Section 1.14 to access to, copies of, or information concerning either the prior application or any continuing application filed under the provisions of 37 C.F.R. Section 1.53(d), may be given similar access to, copies of, or similar information concerning the other application or applications in the file jacket. 37 C.F.R. Section 1.53(d)(6).
- * Filing of this request is the specific reference required by 35 U.S.C. Section 120 to every application assigned the application number identified in this request and that no amendment in this application may delete this specific reference to any prior application. 37 C.F.R. Sections 1.53(d)(7) and 1.78(a)(2).

4. This continued prosecution application names as inventors:

- ☐ the same inventors named in the prior application on the date this continued prosecution application under 37 C.F.R. Section 1.53(d)(2)(iii) is being filed.
- ☐ fewer than all the inventors named in the prior application. 37 C.F.R. Section 1.53(d)(4).

NOTE: A CPA application may be filed by fewer than all the inventors named in the prior application, provided the request for an application under 3.7 C.F.R. Section 1.53(d), when filed, is accompanied by a statement requesting deletion of the name(s) of the person(s) who are not the inventors of the invention being claimed in the new application. 37 C.F.R. Section (d)(4).

- ☐ please delete the following name(s) as inventor(s), who are not inventor(s) of the invention being claimed in this new application:

NOTE: "No person may be named as an inventor in an application filed under this paragraph who was not named as an inventor in the prior application on the date the application under this paragraph was filed, except by way of a petition under Section 1.48." 37 C.F.R. Section 1.53(d)(4).

NOTE: A request for an application under Section 1.53(d) purporting to name as an inventor a person not named as an inventor in the prior application (even if accompanied by a new declaration/oath under Section 1.63 listing that person as an inventor) will be treated as naming the same inventors named in the prior application (Section 1.53(d)(2)(iii)). 62 Fed. Reg. 53,131, 53,141, October 10, 1997.

- ☐ Please add the following name(s) as inventors:

- ☐ A petition under Section 1.48 is attached.

5. ☐ An amendment to the prior application as it existed prior to the filing of this

continuation prosecution application is ☐ attached
☐ not attached

☐ Please enter in this CPA application the unentered amendment under 37 C.F.R. Section 1.116 filed in the prior application.

NOTE: *"Any new change must be made in the form of an amendment to the prior application as it existed prior to the filing of an application under this paragraph. No amendment in an application under this paragraph (a continued prosecution application) may introduce new matter or matter that would have been new matter in the prior application. Any new specification filed with the request for an application under this paragraph will not be considered part of the original application papers, but will be treated as a substitute specification in accordance with Section 1.125." However, the applicant must comply with the requirements of 37 C.F.R. Section 1.125(b) before the substitute specification will be entered into the CPA. 37 C.F.R. Section 1.53(d)(5).*

WARNING: *An amendment after final filed and refused entry in the prior application will not be automatically entered in the CPA and specific instructions to enter amendment(s) refused entry in the prior application must be filed. Q&A 64, "Changes in Patent Practice and Procedure," effective December 1, 1997, supplemented up to February 1, 1998.*

WARNING: *"The original disclosure of a CPA is the same as the original disclosure of the parent non-continued prosecution application and amendments entered in the parent application(s). However, any subject matter added by amendment in the parent application which is deemed to be new matter in the parent application will also be considered new matter in the CPA. No amendment filed in a CPA, even if filed on the filing date of the CPA, may include new matter." M.P.E.P. Section 201.06(d), 7th ed.*

6. Information Disclosure Statement

NOTE: *All information disclosure statements filed in the prior application that comply with the content requirements of 37 C.F.R. Section 1.98 will be considered in a CPA by the examiner. No specific request that the previously submitted information be considered in a CPA is required.*

"In addition, all information disclosure statements that comply with the content requirements of 37 C.F.R. Section 1.98 and are filed within three months of the filing date of a CPA will be considered by the examiner, regardless of whatever else has occurred in the examination process up to that point in time. Thus, in the rare instance that a final Office action or a notice of allowance is prepared and mailed prior to a date which is 3 months from the filing date of the CPA, any information contained in an information disclosure statement complying with 37 C.F.R. Section 1.98, and filed within that 3-month window must be considered by the examiner. . . . [I]t should be expected that a first Office action will normally issue in a CPA well within three months from the filing date of the CPA request. The submission of an information disclosure statement after the first Office action is mailed could delay prosecution and result in the lost of patent term. Therefore, applicants are encouraged to file any information disclosure statement in a CPA as early possible, preferably before the first Office action. . . ." M.P.E.P. Section 201.06(d), 7th ed.

☐ Enclosed is an Information Disclosure Statement in accordance with the requirements of 37 C.F.R. Section 1.98.

7. Fee Calculation

NOTE: "(3) The filing fee for a continued prosecution application filed under this paragraph is:

(i) The basic filing fee as set forth in Section 1.16; and

(ii) Any additional Section 1.16 fee due based on the number of claims remaining in the application after entry of any amendment accompanying the request for an application under this paragraph and entry of any amendments under Section 1.116 unentered in the prior application which applicant has requested to be entered in the continued prosecution application."

37 C.F.R. Section 1.53(d)(3)(i) and (ii).

A. ☒ Regular application

CLAIMS AS FILED					
Claims	Number Filed	Basic Fee Allowance	Number Extra	Rate	Basic Fee 37 C.F.R. Section 1.16(a) \$740.00
Total Claims (37 C.F.R. Section 1.16(c))		-20 =	x	\$18.00	
Independent Claims (37 C.F.R. Section 1.16(b))		- 3 =	x	\$84.00	
Multiple Dependent Claim(s), if any (37 C.F.R. Section 1.16(d))			+	\$280.00	

- ☐ Amendment canceling extra claims is enclosed.
☐ Amendment deleting multiple-dependencies is enclosed.
☐ Fee for extra claims is not being paid at this time.

NOTE: If the fees for extra claims are not paid on filing they must be paid or the claims canceled by amendment, prior to the expiration of the time period set for response by the Patent and Trademark Office in any notice of fee deficiency. 37 C.F.R. Section 1.16(d).

Filing Fee Calculation \$ _____

B. ☐ Design application
(\$330.00--37 C.F.R. Section 1.16(f))

Filing Fee Calculation \$ _____

C. ☐ Plant application
(\$510.00--37 C.F.R. Section 1.16(g))

Filing Fee Calculation \$ _____

8. Small Entity Statement(s)

WARNING: *Small entity status must not be established unless the person(s) signing the statement can unequivocally make the required self-certification. M.P.E.P. Section 509.03, 6th ed., rev. 2, July 1996. (emphasis added).*

[] Statement(s) or Written Assertion(s) that this is a filing by a small entity under 37 C.F.R. Sections 1.9 and 1.27 is (are) attached.

NOTE: *37 C.F.R. § 1.27(c) deals with the assertion of small entity status, whether by a written specific declaration thereof or by payment as a small entity of the basic filing fee or the fee for the entry into the national phase and states:*

"(c) Assertion of small entity status. Any party (person, small business concern or nonprofit organization) should make a determination, pursuant to paragraph (f) of this section, of entitlement to be accorded small entity status based on the definitions set forth in paragraph (a) of this section, and must, in order to establish small entity status for the purpose of paying small entity fees, actually make an assertion of entitlement to small entity status, in the manner set forth in paragraphs (c)(1) or (c)(3) of this section, in the application or patent in which such small entity fees are to be paid.

(1) Assertion by writing. Small entity status may be established by a written assertion of entitlement to small entity status. A written assertion must:

(i) Be clearly identifiable;

(ii) Be signed (see paragraph (c)(2) of this section); and

(iii) Convey the concept of entitlement to small entity status, such as by stating that applicant is a small entity, or that small entity status is entitled to be asserted for the application or patent. While no specific words or wording are required to assert small entity status, the intent to assert small entity status must be clearly indicated in order to comply with the assertion requirement.

(2) Parties who can sign and file the written assertion. The written assertion can be signed by:

(i) One of the parties identified in § 1.33(b) (e.g., an attorney or agent registered with the Office), § 3.73(b) of this chapter notwithstanding, who can also file the written assertion;

(ii) At least one of the individuals identified as an inventor (even though a § 1.63 executed oath or declaration has not been submitted), notwithstanding § 1.33(b)(4), who can also file the written assertion pursuant to the exception under § 1.33(b) of this part; or

(iii) An assignee of an undivided part interest, notwithstanding §§ 1.33(b)(3) and 3.73(b) of this chapter, but the partial assignee cannot file the assertion without resort to a party identified under § 1.33(b) of this part.

(3) Assertion by payment of the small entity basic filing or basic national fee. The payment, by any party, of the exact amount of one of the small entity basic filing fees set forth in §§ 1.16(a), (f), (g), (h), or (k), or one of the small entity basic national fees set forth in §§ 1.492(a)(1), (a)(2), (a)(3), (a)(4), or (a)(5), will be treated as a written assertion of entitlement to small entity status even if the type of basic filing or basic national fee is inadvertently selected in error.

(i) If the Office accords small entity status based on payment of a small entity basic filing or basic national fee under paragraph (c)(3) of this section that is not applicable to that application, any balance of the small entity fee that is applicable to that application will be due along with the appropriate surcharge set forth in § 1.16(e), or § 1.16(f).

(ii) The payment of any small entity fee other than those set forth in paragraph (c)(3) of this section (whether in the exact fee amount or not) will not be treated as a written assertion of entitlement to small entity status and will not be sufficient to establish small entity status in an application or a patent."

WARNING: *"Small entity status must not be established when the person or persons signing the . . . statement can unequivocally make the required self-certification." M.P.E.P., Section 509.03 7th ed., (emphasis added).*

[] Status as a small entity was claimed in prior application _____, filed on _____, from which benefit is being claimed for this application under:

and which status as a small entity is still proper and desired.

Filing Fee Calculation (50% of A, B or C above)

NOTE: *A refund based on establishment of small entity status, of a portion of fees timely paid in full prior to establishing status as a small entity may only be obtained if an assertion under § 1.27(c) and a requests for a refund of the excess amount are filed within three months of the date of the timely payment of the full fee. The three-month time period is not extendable under § 1.136. 37 C.F.R. § 1.28(a).*

☒ Not Enclosed. No filing fee is to be paid at this time. Applicant hereby revokes any general authorization to pay fees filed in the prior non-provisional application of which this is a CPA.

NOTE: *Since a general authorization to charge fees to a deposit account in the prior nonprovisional application carries over to the CPA, where the applicant desires to file the CPA without paying the filing fee on the filing date of the application, the applicant may file the CPA with specific instructions revoking the general authorization filed in the prior application. M.P.E.P. Section 201.06(d), 7th ed.*

[] Enclosed

NOTE: An applicant filing a CPA by facsimile must include an authorization to charge the basic filing fee to a deposit account, or the application will be treated under 37 C.F.R. Section 1.53(f) as having been filed without the basic filing fee (as fees cannot otherwise be transmitted by facsimile. M.P.E.P. Section 201.06(d), 7th ed.

NOTE: A general authorization to charge fees to a deposit account filed in the prior nonprovisional application carries over to a CPA and, in such a situation, the necessary filing fee will be charged to the deposit account. M.P.E.P. Section 201.06(d), 7th ed.

☐ Filing fee \$ _____

NOTE: Payment of a small entity basic filing fee will be treated as a reference to the statements in the prior application that status as a small entity is desired and proper. 37 C.F.R. Section 1.28(a)(2).

☐ Recording assignment
(\$40.00; 37 C.F.R. Section 1.21(h))
(See attached "COVER SHEET FOR ASSIGNMENT
ACCOMPANYING NEW APPLICATION.") \$ _____

☐ Petition fee for filing by other than all the
inventors or person on behalf of the inventor
where inventor refused to sign or cannot be reached
(\$130.00; 37 C.F.R. Section 1.47 and 1.17(i)) \$ _____

Total filing fees enclosed \$ _____

TOTAL FEE DUE

The total fee due is:

Filing Fee \$ _____
Extension fee (if any) \$ _____

TOTAL FEE DUE \$ _____

10. Method of Payment of Fees

☒ Check in the amount of \$ 920.00.
☐ Charge Account No. _____ in the amount of \$ _____.
A duplicate of this transmittal is attached.

NOTE: Fees should be itemized in such a manner that it is clear for which purpose the fees are paid. 37 C.F.R. Section 1.22(b).

WARNING: Unless an application under Section 1.53(d) filed by facsimile includes an authorization to charge the basic filing fee to a deposit account, the applicant will be given a notification requiring payment of the appropriate filing fee (Section 1.53(d)(3)) and the late filing surcharge under Section 1.16(e) to avoid abandonment of the Section 1.53(d) application. 62 Fed. Reg. 53,131, 53,133 (Oct. 10, 1997).

11. Authorization to Charge Additional Fees

WARNING: *If no fees are to be paid on filing, the following items should not be completed.*

WARNING: *Accurately count claims, especially multiple dependent claims, to avoid unexpected high charges, if extra claim charges are authorized.*

[X] The Commissioner is hereby authorized to charge the following additional fees by this paper and during the entire pendency of this application to Account No. 12-0425.

☐ 37 C.F.R. Section 1.16(a), (f) or (g) (filing fees)

☐ 37 C.F.R. Section 1.16(b), (c) and (d) (presentation of extra claims)

NOTE: *Because additional fees for excess or multiple dependent claims not paid on filing or on later presentation must only be paid or these claims cancelled by amendment prior to the expiration of the time period set for response by the PTO in any notice of fee deficiency (37 C.F.R. Section 1.16(d)), it might be best not to authorize the PTO to charge additional claim fees, except possibly when dealing with amendments after final action.*

☐ 37 C.F.R. Section 1.16(e) (surcharge for filing the basic filing fee and/or declaration on a date later than the filing date of the application)

[X] 37 C.F.R. Section 1.17(a)(1)-(5) (extension fees pursuant to Section 1.136(a))

☐ 37 C.F.R. Section 1.17 (application processing fees)

WARNING: *"A written request may be submitted in an application that is an authorization to treat any concurrent or future reply, requiring a petition for an extension of time under this paragraph for its timely submission, as incorporating a petition for extension of time for the appropriate length of time. An authorization to charge all required fees, fees under Section 1.17, or all required extension of time fees will be treated as a constructive petition for an extension of time in any concurrent or future reply requiring a petition for an extension of time under this paragraph for its timely submission. Submission of the fee set forth in Section 1.17(a) will also be treated as a constructive petition for an extension of time in any concurrent reply requiring a petition for an extension of time under this paragraph for its timely submission." 37 C.F.R. Section 1.136(a)(3).*

☐ 37 C.F.R. Section 1.18 (issue fee at or before mailing of Notice of Allowance, pursuant to 37 C.F.R. Section 1.311(b))

NOTE: *Where an authorization to charge the issue fee to a deposit account has been filed before the mailing of a Notice of Allowance, the issue fee will be automatically charged to the deposit account at the time of mailing the notice of allowance: 37 C.F.R. Section 1.311(b).*

NOTE: *37 C.F.R. Section 1.28(b) requires "Notification of any change in status resulting in loss of entitlement to small entity status must be filed in the application . . . prior to paying, or at the time of paying, . . . issue fee." From the wording of 37 C.F.R. Section 1.28(b), (a) notification of change of status must be made even if the fee is paid as "other than a small entity" and (b) no notification is required if the change is to another small entity.*